
IN THE
United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT.

PEVELY DAIRY COMPANY, a
Corporation,
v.
BORDEN PRINTING COMPANY, a
Corporation,

Appellant,
Appellee.

No. 9,744.

BRIEF FOR APPELLANT.

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BRIEF FOR APPELLANT.

STATEMENT.

This is an appeal by plaintiff¹ in a patent infringement suit. The appeal is based upon two patents that issued to plaintiff, Pevely Dairy Company of St. Louis, Missouri, the inventions having been made by Joseph J. Wasser, the manager of the dairy.

This is more than the usual infringement suit, because an entire business has been built upon these two patents over a period of ten years prior to the invasion by defendant. The business was created by these inventions and has continued because of them. The principal issues before this Court are not only the rights under the patents, but also the protection of the business itself.

A further distinction over the usual patent suit exists in that the two patents on appeal have been sustained in

¹Appellant will be designated plaintiff and appellee designated defendant.

a court outside of this circuit, and, in being sustained, they weathered the fire of a heated attack and came out with generous interpretations.

Jurisdiction.

Jurisdiction of the District Court of this suit was based upon the patent laws (28 U. S. C. 41) as pleaded in the bill of complaint (R. 2). Appeal to this Court is based upon the statutory right of appeal from final decrees (28 U. S. C. 225).

Background of the Inventions.

The present case deals primarily with the dairy industry, said to be the biggest industry in the United States. The inventions are applicable to other industries, but the plaintiff is a dairy, the plaintiff's licensee is mainly interested in dairies, and the accused devices have been sold by defendant for use by dairies.

These inventions relate to advertising devices. The primary purpose of all advertising is to reach the ultimate consumer personally and individually. The purpose of the inventions here involved is to reach each housewife with advertisements of the dairy's various products.

The bottle of milk itself is an ideal medium for carrying advertising matter of the dairy to every family. But the use of the milk bottle as a carrying medium is not simple, because of mechanical problems as well as a large human element involved in its distribution.

Although the use of the milk bottle itself as a carrying medium for advertising has long been recognized, there was, prior to the advent of the present inventions, only one commercially adopted advertising device used in this manner. It was the flat hanger.

The Flat Hanger.

Testimony of witnesses of both plaintiff and defendant demonstrates that the flat hanger was the only medium

commercially adopted for this type of advertising (R. 103, 114, 213). It is represented herein by Defendant's Exhibits D, E, F and G. It consists of a single flat piece of paper with a hole at one end slightly larger than the flange of the bottle, so that it may engage over the bottle neck. Its disposition on the bottle is somewhat in the form of a projecting and overhanging drape.

The use of flat hangers was greatly restricted by their inherent limitations and disadvantages. Flat hangers project a substantial distance beyond the outer limits of the bottles, so that they cannot be placed on prior to putting the bottles in their familiar cases for delivery, since they would be immediately subject to being *torn off by the partitions* in the cases (R. 106, 120).

Flat hangers *cannot* be placed in cases that are to be *iced*, because the overhanging nature of the flat hangers would cause them to be torn off or mutilated as soon as ice is packed around the bottles in the cases (R. 153). Also, the flat hangers *cannot stand wetting*, as they are too fragile (R. 120). In this territory cases leaving the dairies for the delivery wagons must be iced during a substantial period of the summer (R. 106).

Consequently, the flat hangers *cannot be put on at the dairies* by a single operator over whom supervision can be had (R. 106, 153). They must be put on by the drivers themselves, which fact causes the dairies to be dependent upon an extra curriculum activity of the drivers lying at the heart of the success of the advertising, namely, getting the matter before the customers (R. 106, 115). As Stewart said on cross-examination (R. 110):

“Q. When you spoke of the advantages that you thought the collar had over paper hangers weren't those advantages more or less incident to some particular article or particular type of message you wanted to convey? A. No. It is not a matter of the

message so much as the ability of the piece of advertising to reach the consumer.”

Experience taught that the drivers were very lax in putting the hangers on the bottles (R. 115). Even when on, the hangers were *insecure* and frequently were *torn off*, frequently *blew off*, before ever reaching the householder (R. 104).

The overall *efficiency* of the flat hanger was only about 25% to 50% (R. 109, 114). Even so, they were the only medium adopted commercially for this type of advertising prior to the creation of the present inventions.

Origin of the Bottle Collar.

Neher is a man of long experience in the dairy industry, and particularly in the field of dairy advertising (R. 113). Neher's company had suffered from the deficiency of the flat hanger type of advertising (R. 116). Joseph Wasser, the inventor here, was advertising and salesmanager for plaintiff, which is a dairy in St. Louis of substantial size (R. 117). In Wasser's experiments, searching for a satisfactory advertising medium, he produced sample bottle collars of the present inventions (id). About 1928 Neher, calling on Wasser, saw the bottle collar on Wasser's desk. Neher's own testimony is (R. 117):

“Well, I realized this was just the thing that we had been contacting the industry on for years, just as soon as I laid my eyes on that *I saw instantly that that was the answer to our problem*,¹ so we made a contract with the Pevely Dairy Company at that time, that was in 1928, for the exclusive right, and started off with the bottle collar business.”

Neher further testified (R. 120):

“Q. In 1928 when you first had this called to your attention had you, as an advertising man in the dairy

¹Italics always added unless indicated otherwise.

industry, been looking for some satisfactory advertising medium for the business? A. Yes.

Q. You have stated that you were impressed at the time you first saw this as a solution for that problem?

A. Immediately, yes.

Q. In other words, were you able to recognize it as meeting the requirement when you first examined it?

A. Instantly, instantly."

The Nature of the Bottle Collar.

The difference between the bottle collar and the flat hanger is immediately apparent. Now, the bottle collar is simple. Plaintiff does not want to make it appear complicated, because plaintiff feels that a great part of its virtue lies in its simplicity. But plaintiff wants this fact to be recognized at the outset of this case: *The bottle collars of the patents in suit are not merely strips of paper wound about the necks of milk bottles.* They are not mere Eton collars translated to necks of milk bottles instead of necks of schoolboys. For there were problems of a very real nature involved in getting good bottle collars.

This appeal is not based upon the adoption by the defendant of mere labels for the necks of milk bottles. It is based upon the copying by the defendant of the plaintiff's particularly desirable constructions of bottle collars.

Plaintiff feels that the inevitable effect of defendant's acts of appropriation is that plaintiff's bottle collars are more than ordinarily desirable. They are so far superior to any kind of bottle collar that no other can compete. Plaintiff will contend that, by that very token, its bottle collars are inventive.

An understanding of a bottle collar requires consideration of the shape of a milk bottle. A milk bottle has a main body portion more or less cylindrical. It has a tapering neck surmounted by an overhanging flange. Each one of these dimensions is subject to variation.

Bottles have had labels on their necks from time imme-

morial, but a mere label will not accomplish the desired result on a milk bottle because of the nature of the use of the milk bottle and because of the nature of the advertising which is obtainable on a bottle collar. The first thing is that the bottle collar is not permanently attached to the bottle. This is necessary for two reasons. The first is that the bottle collar is designed to carry a single message at a time, so that, over a period of time, a series of messages may be transmitted. And a bottle collar must be removable because the milk bottles are used a large number of times, probably somewhere between forty and eighty times on the average. Each time, the bottle must be thoroughly washed and sterilized in machinery at the dairy.

This removability brings up the matter of expense. A single advertising item cannot be expensive lest it be prohibitive in cost. A removable collar is cheaper than one that is glued to the bottle.

To be unattached to the bottle, the collar must be capable of easy application (R. 117). The element of expense enters in, because the labor of putting the collars on the bottles must not involve large costs. It has been pointed out that it is inefficient to rely upon the drivers to install the advertising medium. The collar can be installed at the dairy where its installation is subject to supervision. This property, however, depends upon the staying qualities of the bottle collar, so that it may survive until it reaches the consumer.

For proper installation, the bottle collar must slip over the flange of the bottle readily (R. 119). This means that its upper opening must be capable of slipping over the enlarged flange. But this injects another problem. The collar must fit snugly against the tapered neck of the bottle (R. 118). Otherwise, it cannot survive crating, icing, transportation and wind (R. 119). The old type of label on tapered bottle necks did not have these problems and could not meet them.

The ideal bottle collars of the Wasser patents meet these problems of slipping easily over the bottle flange, but nevertheless fitting snugly on the bottle neck, and also providing large advertising space. To obtain a fit over the flange may not be done by merely cutting the collars down until the upper diameter is large enough, because such an upper diameter is so large that the bottle collars become too narrow, and will not stick on the bottles. Nor will they fit snugly, as Neher said, "like a glove" (R. 117).

The Wasser Patents on Appeal.

Wasser designed two bottle collars that would fit snugly "like a glove" on the tapered necks of milk bottles, that would fit over the flanges of the bottles easily, and that would carry adequate advertising space. A third patent, 1,953,856, was in the trial of the case, but no appeal is taken as to it. Defendant, it will be shown, has appropriated the particular ways of gaining these ends invented by Wasser.

Wasser Patent No. 1,829,915.

This patent 1,829,915 explains the features of the type of collar shown in it. It says (R. 353, line 62) that the collars are designed (*id.*, line 62)

"so as to provide approximately conical display devices constructed in proportion, so that the display devices may be passed downwardly over the flange at the end of the bottle neck without tearing the paper, and then seated upon the tapered portion of the bottle."

In order to accomplish the functions both of passing over the flange and of fitting snugly onto the bottle neck, the collar has its previously described size and shape, together with a connection making that size and that shape practicable, the patent describing provision of a connection (*id.*, line 68)

“so that the ends may be connected by a form of interlocking pivotal connection which will permit the smaller end of each display device to be opened larger than its normal position and thus passed over the bottle neck flange without damaging or tearing the paper.”

See, also, the description beginning on line 49 (R. 354). The so-called pivotal connection, as merely a means of joining two pieces or ends together, is like a hinge without a door. But *combined* with the size and shape of the arcuate strip, so that it enables the collar to pass over the flange, and to adjust itself to the peculiar taper of whatever milk bottle it happens to be used on, and yet give good advertising space, the pivotal connection has purpose and meaning.

The foregoing invention is typified by claim 4 of the patent. This claim may be divided into its elements as follows:

1. A display device for application to a bottle having a cylindrical body portion, a tapered neck portion defining an enlarged mouth, and an enlarged top flange; said device comprising
2. an arcuate piece of pliable material adapted to be formed into a truncated conical member having
3. a lower diameter approximately equal to the diameter of the body portion of the bottle and
4. an upper diameter approximately equal to an intermediate diameter of the tapered neck portion of the bottle, and
5. means for so connecting the ends of said arcuate piece as to hold the same in the form of the truncated conical member and permitting enlargement of the upper diameter of the member.

Note that the connecting means is not necessarily pivotal. The term is for convenience and not accuracy, as claim 4 merely requires a connection that permits enlargement of the upper diameter.

Wasser Patent No. 1,999,011.

A second type of bottle collar that could fit snugly on the neck of the bottle is represented in Wasser's patent No. 1,999,011 (R. 382). This patent accomplishes the effect of slipping over the flange and resting snugly on the neck of the bottle by a different construction. It is shaped, as we shall show, so that its bottom portion extends around the milk bottle approximately at the junction of the neck and body portion thereof. Its upper diameter reaches a maximum height on the tapered neck at a point where the corresponding diameter on the bottle would become too small to permit the collar to be passed over the flange of the bottle.

In the previous type of collar, this difficulty has been overcome by the use of the pivotal connection. In this second type, the problem has been overcome *despite not* having the pivotal connection. The means here employed is to cut the upper edge of the arcuate strip of material in suchwise that the collar will extend higher on the front portion than on the rear portion, so that the total perimeter of the top edge of the collar is as great as or slightly greater than the perimeter of the bottle flange. In its strip form, the collar is wider in the middle than at its ends. The patent itself says (R. 386, col. 1, line 38):

“ * * * Due to the intermediate portion of the strip being of greater width than the end portions, the intermediate portion of the upper edge of the strip, when the strip is shaped to form a cone, will more closely approach the apex of the cone than will the portion of the upper edge of the cone which is formed by the overlapped ends of the strip. Expressed in a different way, the portion of the upper edge of the cone formed by the widest portion of the strip, will more closely approach the axis of the cone which is normal to the plane occupied by the lower edge of the cone.”

By this means the collar may pass over the flange, but nevertheless fit snugly on the tapered neck of the bottle, extend well up on that neck to give adequate advertising space, and for all of this take advantage of a secure attaching means which is immovable, that is to say, does not pivot. As explained in the more technical language of the patent (*id.*, line 52):

“As stated above, the strip is made of proper size so that the smaller end of the cone will just pass over the flanged upper end of the bottle. When the cone is applied to a bottle, its upper edge is concentrically arranged with respect to the bottle axis to obtain the benefit of the full diameter of this smaller opening. When the cone settles onto the enlarged shoulder portion of the bottle, the cone will rest evenly on the bottle, with the lower edge of the cone concentric with the axis of the bottle, or with the plane occupied by the lower edge of the cone normal to the axis of the bottle. This shifting of the cone relative to the bottle axis will render the smaller, upper opening eccentric with respect to the bottle axis and will cause a portion of the upper edge of the cone, formed by the intermediate portion of the strip, to contact with the neck portion of the bottle and to underlie the flange at the upper end of the bottle. This contacting with the bottle neck will tend to prevent rocking of the cone on the bottle. This same portion of the upper edge of the cone, due to its underlying the flange, will tend to cause the said portion of the edge to catch on the flange to prevent the cone from falling off of the bottle should the latter be inverted.”

A number of different immovable connections are shown in the patent. For instance, there are glue, stitching, and stapling and, in Fig. 9 (R. 384), a folding together of the paper of the collar itself wherein there is a tongue on one end folded through an opening on the other. Of course, no claim is made to these attaching means as such, the claim being directed to any form of immovable connection

combined with the size and shape and construction of the strip that can give the removable connection significance.

Claim 3 here in suit of this patent 1,999,011 includes the following elements as a combination (R. 387):

1. A display device for application to a bottle having a cylindrical body portion, a tapered neck, and an enlarged top flange, said device comprising

2. an arcuate piece of pliable material adapted to be formed into a truncated cone by overlapping the ends and having

3. a lower diameter approximately equal to the body portion of the bottle and

4. an upper diameter approximately equal to the top flange of the bottle,

5. the wall of the cone being so shaped that when the lower edge of the device is concentric with the longitudinal axis of the bottle portions the upper edge of the device will be located different distances from said axis,

6. and means for immovably connecting the overlapping ends of the piece of material.

It will be manifest from a bare reading of the claim that it involves a *combination* of six elements.

It is these two different inventions with which this appeal is concerned. The one is the bottle collar having elements of certain sizes and shapes, *and* the pivotal connection, the sizes and shapes making the pivotal connection significant; and the other is the collar having elements of certain sizes and shapes so that it can be made and used with the immovable connection.

The Virtues of These Bottle Collars.

As contrasted with the flat hangers, bottle collars do not project beyond the outer limits of the body portion of the bottles. Hence, they may be applied in the dairies under supervision prior to crating of the bottles. There are no

overhanging portions that can snag on the crate partitions (R. 105).

The bottle collars fit snugly about the tapered necks of the bottles (R. 117), so that ice and dampness do not destroy them. Their snug fit prevents the ice pieces from tearing the collars (id.).

The bottle collars do not leave the dairies dependent upon the drivers (R. 115), so that their efficiency becomes 75% to 100% instead of 25% to 50% (R. 109, 118).

The bottle collars also may be easily installed because they pass readily over the flange of the bottles (R. 119). Yet, they have a large advertising space because each construction of the two patents in suit permits the collars to come high onto the bottle necks.

Defendant has not merely made display devices. It has appropriated these inventions.

The Accused Collars.

The accused collars comprise Plaintiff's Exhibits 3, 4, 5, 21 and 22. Accurate tracings of these bottle collars appear in Exhibit 28.

Exhibit 3 consists of an arcuate strip of material adapted to be shaped into the form of a cone designed so that it has a lower diameter approximately equal to the diameter of the body portion of the bottle, and an upper diameter equal to a diameter on the neck, and a connection for the ends of the strip consisting of a tab and a slot. The tab is hooked into the slot on one edge.

Exhibit 4 is similar to Exhibit 3 as to its being an arcuate strip and as to its having the upper and lower diameters as previously indicated and as to having a tab and a slot connection. However, the tab is varied somewhat in this exhibit so as to have an overhanging portion on both opposite sides of the tab.

Exhibit 5 is a variant in shape more similar to Exhibit

3. It is understood that this collar was used only for a short time and is not now in use.

Exhibit 21 has the arcuate strip of material with the lower diameter approximately equal to that of the body portion and an upper diameter equal to an intermediate diameter of the neck of the bottle and with a variant of the connecting means over those previously shown. One end has a double V-shaped notch engageable by two opposite tongues on the other end of the strip. Both tongues are slipped into the notch and they are caused to engage the opposite straight edges thereof.

Exhibit 22 is identical with Exhibit 21 except for having added thereto a folder which folds against the collar and constitutes merely the addition of another piece of paper.

The Claims Involved.

Of patent No. 1,889,915, claims 4, 7, 8 and 11 are involved. While we shall use claim 4 as illustrative, we do not intend to imply that there are not significant distinctions among these claims. Plaintiff accuses Exhibits 3, 4 and 5 of infringing these claims.

Of patent No. 1,999,011, only claim 3 is involved. Plaintiff accuses Exhibits 21 and 22 of infringing this claim. Also, as will be explained, under defendant's theory as to noninfringement of patent 1,829,915 by Exhibits 3, 4 and 5, they must be found to infringe this claim 3 of 1,999,011.

POINTS TO BE RELIED UPON ON APPEAL.

Plaintiff will rely upon the following errors by the lower court (R. 85):

1.

In finding claims 4, 7, 8 and 11 of patent No. 1,829,915 and claim 3 of patent No. 1,999,011 invalid; and in failing to find them valid.

2.

In finding said claims of said patents invalid for anticipation, lack of invention, or lack of novelty.

3.

In finding the inventions of said patents, or any of said inventions, disclosed in prior patents, and particularly in the following patents, or any of them:

Guardino	1,300,164
Taylor	343,866
Goes	1,480,661
Gridley	63,629
Spellman	1,309,263

4.

In failing to find that all of said patents are in non-analogous arts, and in failing to find that they do not describe or suggest the inventions set forth and claimed in appellant's foregoing patents; in failing to apply the law of nonanalogous art to said patents; and in failing to apply the law that patents may not be invalidated on art not disclosing or suggesting their inventions.

5.

In invalidating appellant's patents on one patent, Spellman, over which they were allowed by the Patent Office, and on other patents no better than that patent.

6.

In invalidating the patents on art disclosing only one

feature of appellant's claims, to wit, the particular attachment means; in failing to realize that all the claims are combination claims including other features; and in failing to apply the rule that new combinations of old results may be invention.

7.

In failing to find appellant's patents infringed by appellee's devices, as accused.

8.

In finding that the sole invention of two patents over a third lies in the locking means, in complete disregard of other specified and claimed differences.

9.

In failing to give effect to large commercial success and public recognition of appellant's patents.

10.

In failing to give effect to the fact that appellant's patents, including claims here in suit, were held valid and infringed after full trial in the District Court for the Northern District of Ohio.

11.

In failing to give effect to the fact that appellant's patents were held valid by the said District Court in Ohio over substantially the same art as in this case.

12.

In failing to apply the law that the citation of over ninety-five alleged instances of prior art of itself indicates invention.

13.

In failing to apply the rule that the adoption of the patented construction in preference to all the prior art indicates invention.

14.

In finding that appellee acted in good faith in its infringement, whereas appellee actually manufactured the accused devices in the knowledge and face of appellant's patents.

15.

In admitting Exhibit FF, a collar rejected from the suit because not supplied by appellee's Bill of Particulars in response to appellant's motion for a specification of all collars produced by appellee (Rec. 75, 76, 77), under the spurious and insidious theory that it represented a prior art construction (Rec. 170, 171), whereas it was actually made long after the suit was begun, and could not possibly represent said prior art.

16.

In admitting Exhibit GG (Rec. 172) as of any value in representing the Guardino patent, whereas, as was urged, it is completely altered so as not to typify that patent, and is wholly and insidiously misleading.

17.

In admitting Exhibit II (Rec. 174) as of any value in representing the Taylor patent, whereas it is completely altered so as not to typify that patent, and is wholly and insidiously misleading.

18.

In admitting Exhibit JJ (Rec. 175) as of any value in representing the Goes patent, whereas it is completely altered so as not to typify that patent, and is wholly and insidiously misleading.

19.

In admitting Exhibit KK (Rec. 177) as of any value in representing the Gridley patent, whereas it is completely altered so as not to typify that patent, and is wholly and insidiously misleading.

20.

In admitting Exhibits LL and LL-1, being boxes, not having any connection with the case, and not having any status as prior art.

21.

In dismissing the bill of complaint.

OUTLINE OF ARGUMENT AND POINTS OF LAW.

1.

The Wasser patents filled a long-felt need, which is evidence that they involved invention.

Pyle Nat. Co. v. Lewin, 92 F. (2d) 628, 630 (C. C. A. 7);

Expanded Metal Co. v. Bradford, 214 U. S. 366, 381, 53 L. ed. 1034;

Forestek Plating & Mfg. Co. v. Knapp-Monarch Co., 106 F. (2d) 554 (C. C. A. 6);

Crowder v. Armour, 105 F. (2d) 232 (C. C. A. 7).

2.

Without fanfare, the Wasser inventions achieved outstanding commercial success, selling over 438,000,000 for over \$1,000,000, all over the country, to many customers, great and small. This is further evidence that the devices constituted invention.

Research Products Co. v. Tretolite Co., 106 F. (2d) 530 (C. C. A. 9);

Forestek Plating & Mfg. Co. v. Knapp-Monarch Co., 106 F. (2d) 554 (C. C. A. 6);

Bankers' Utilities Co. v. Pacific National Bank, 18 F. (2d) 16 (C. C. A. 9);

Mineral Separation v. Hyde, 242 U. S. 261, 61 L. ed. 280;

Eibel Process Co. v. Minnesota & O. Paper Co., 261 U. S. 45, 67 L. ed. 523;

Ace Patents Corp. v. The Exhibit Supply Co., ... F. (2d) ..., 48 USPQ 667 (C. C. A. 7).

That invention is present is strongly supported by the admission by defendant of the utility of the devices.

National Nut Co. v. Sontag Chain Stores Co., 107 F. (2d) 318 (C. C. A. 9) (rev. o. g.);

The Cincinnati Rubber Mfg. Co. v. Stowe-Woodward, Inc., 111 F. (2d) 239 (C. C. A. 6).

3.

The public has acquiesced in the validity of the patents. A number of infringers have ceased infringement on notice and by consent decrees. This corroborates the validity of the patents.

Keasbey & Mattison Co. v. Philip Carey Mfg. Co.,
139 F. 571.

4.

Infringement of Wasser 1,829,915 is shown by defendant having adopted the same combination of elements claimed by the patent, to obtain the identical advantages set forth in that patent.

Wire Tie Mach. Co. v. Pacific Box Co., 102 F. (2d)
543 (C. C. A. 9);

Nordberg Mfg. Co. v. Woolery Mach. Co., 79 F. (2d)
685 (C. C. A. 7);

Chicago Pneumatic Tool Co. v. Hughes, 97 F. (2d)
945 (C. C. A. 10);

Reinharts, Inc., v. Caterpillar T. Corp., 85 F. (2d)
628 (C. C. A. 9);

Weiss v. R. Hoe & Co., 109 F. (2d) 722 (C. C. A. 2).

a. Exhibits 3 and 4 have a connection permitting enlargement of the upper diameter of the device, adopted for the manifest purpose of obtaining the properties of passing over the bottle flange and adapting themselves to the taper of the bottle neck. Exhibits 3 and 4 also have the remaining elements of the claims of patent 1,829,915, which coact with the so-called "pivotal" connection to produce a new overall result.

b. There can be no defense that defendant's collars are not "approximately" equal to the diameter specified by the claims.

Chicago Pneumatic Tool Co. v. Hughes Tool Co.,
97 F. (2d) 945 (C. C. A. 10);

Weiss v. R. Hoe & Co., 109 F. (2d) 722 (C. C. A. 2).

5.

Infringement of Wasser patent 1,990,111 by Exhibits 21 and 22 is unmistakably present. These collars adopt Wasser's invention of the shape and size of the edges of the collar made so as to enable a fixed connection to be used. The accused exhibits do the same thing for the same purpose.

Wire Tie Mach. Co. v. Pacific Box Co., 102 F. (2d) 543 (C. C. A. 9);

Nordberg Mfg. Co. v. Woolery Mach. Co., 79 F. (2d) 685 (C. C. A. 7);

Chicago Pneumatic Tool Co. v. Hughes, 97 F. (2d) 945 (C. C. A. 10);

Reinharts v. Caterpillar T. Corp., 85 F. (2d) 628, 636 (C. C. A. 9);

Weiss v. R. Hoe & Co., 109 F. (2d) 722 (C. C. A. 2).

a. The claim of this patent does not require the lower edge of the device to be *exactly* equal to the diameter of the body portion of the bottle, but only *approximately* equal. This term used certainly encompasses such minor variations as defendant claims are present in the exhibits.

Chicago Pneumatic Tool Co. v. Hughes Tool Co., 97 F. (2d) 945 (C. C. A. 10);

Weiss v. R. Hoe & Co., 109 F. (2d) 722 (C. C. A. 2).

b. The addition in Exhibit 22 of an entirely supplementary element does not avoid infringement.

Angelus Sanitary Can Mach. Co. v. Wilson, 7 F. (2d) 314, 318 (C. C. A. 9);

Stebler v. Riverside H. Orange Growers' Ass'n, 205 F. 735, 739 (C. C. A. 9);

Butler v. Burch Plow Co., 23 F. (2d) 15 (C. C. A. 9);

Hoeltke v. C. M. Kemp Mfg. Co., 80 F. (2d) 912, 921 (C. C. A. 4).

c. Exhibits 3, 4 and 5 infringe claim 3 of patent 1,999,011 if defendant is held correct that their connections do not permit enlargement of the upper diameter.

6.

There is no nonjoinder of an indispensable party here. Neher Whitehead & Co. is not an exclusive licensee.

Waterman v. Mackenzie, 138 U. S. 252, 34 L. ed. 923;
Hayward v. Andrews, 106 U. S. 672, 27 L. ed. 271;
*Independent Wireless Tel. Co. v. Radio Corp. of
America*, 269 U. S. 459, 70 L. ed. 356, 361;
Birdsell v. Shaliol, 12 U. S. 485, 28 L. ed. 768.

7.

There is no double patenting here. There are no generic claims in both patents covering specific claims of both patents.

Research Products v. Tretolite Co., 106 F. (2d) 530
(C. C. A. 9);
Montgomery Ward Co. v. Gibbs, 27 F. (2d) 466, 469
(C. C. A. 4);
Century Electric Co. v. Westinghouse Co., 191 F.
350 (C. C. A. 8);
Palmer v. John E. Brown Mfg. Co., 92 F. 925 (C. C.
A. 1).

8.

The procedure under which the Wasser patents were obtained is familiar and proved.

Crown Cork & Seal Co. v. Gutmann, 304 U. S. 159,
82 L. ed. 1265.

9.

The activities of Neher-Whitehead & Co. could not constitute liabilities for plaintiff; the activities were not unfair competition in any event. Merely giving notice of infringement is not unfair.

Celite Corp. v. Dicalite Co., 96 F. (2d) 242 (C. C.
A. 9);
American Ball Co. v. Federal Cartridge Corp., 70 F.
(2d) 579 (C. C. A. 8).

10.

Invalidity of the Wasser patents is not proved.

Defendant's resort to a huge quantity of prior art items, ninety-seven in the aggregate, itself indicates invention, since it shows how difficult it is to find any good satisfactory reference.

A. S. Boyle Co. v. Harris-Thomas Co., 18 F. Supp. 177, 179;

Forsyth v. Garlock, 142 F. 461 (C. C. A. 1);

Ball Co. v. Sanford Co., 297 F. 163 (C. C. A. 2).

11.

The art relied upon is from wholly remote and nonanalogous fields, could not be used for any bottle collars, and is completely distinct from the combinations of the claims in suit.

Potts v. Creager, 155 U. S. 597, 607, 39 L. ed. 275;

Payne Furnace & Supply Co. v. Williams-Wallace Co., 117 F. (2d) 823 (C. C. A. 9);

Electric Candy Mach. Co. v. Morris, 156 F. 972, 976;

Peerless Equipment Co. v. W. H. Miner, Inc., 93 F. (2d) 98 (C. C. A. 7);

Cold Metal Process Co. v. Carnegie-Illinois Steel Corp., 108 F. (2d) 322 (C. C. A. 3);

Tyra v. Adler, 85 F. (2d) 548 (C. C. A. 8);

National Nut Co. v. Sontag Chain S. Co., 107 F. (2d) 318 (C. C. A. 9, reversed other grounds);

Weiss v. R. Hoe & Co., 109 F. (2d) 722 (C. C. A. 2);

The Cincinnati Rubber Mfg. Co. v. Stowe-Woodward, Inc., 111 F. (2d) 239 (C. C. A. 6).

The patents are presumably valid.

Smith v. Goodyear, 93 U. S. 486, 498, 23 L. ed. 952;

Marsh v. Seymour, 97 U. S. 348, 24 L. ed. 963;

Reinharts, Inc., v. Caterpillar Tractor Co., 85 F. (2d) 628 (C. C. A. 9).

12.

The art relied upon is entirely inferior to that elicited

by the Patent Office, and doubtless was among the art discarded by the Office. It cannot overcome the presumption of validity of the patents.

Nerney v. New York, N. H. R. Co., 6 F. Supp. 554;
Dean Rubber Mfg. Co. v. Killian, 106 F. (2d) 316,
318 (C. C. A. 8).

13.

Defendant bases its whole case of invalidity upon the testimony of an employee in the office of its counsel, who was unqualified in both mechanics and law, and whose testimony is accordingly and clearly unsound.

Gray Processes Corp. v. Danciger Oil & Ref., Inc.,
42 USPQ 315;
Farmers' Cooperative Exchange v. Turnbow, 111
F. (2d) 728 (C. C. A. 9).

14.

A new combination, even using old elements, is patentable if it produces a new and useful result emanating from the juxtaposition of the elements.

H. J. Heinz Co. v. Cohn, 207 F. 547 (C. C. A. 9);
Webster Loom Co. v. Higgins, 105 U. S. 580, 26
L. ed. 1177;
Wire Tie Mach. Co. v. Pacific Box Corp., 102 F. (2d)
543 (C. C. A. 9);
*Cold Metal Process Co. v. Carnegie-Illinois Steel
Co.*, 108 F. (2d) 322 (C. C. A. 3);
*National Hollow B. B. Co. v. Interchangeable B. B.
Co.*, 106 F. 693 (C. C. A. 8);
Weiss v. R. Hoe & Co., 109 F. (2d) 722 (C. C. A. 2).

15.

Combination claims are not met by prior art not indicating the combination, but only showing some elements thereof.

Ace Patents Corp. v. The Exhibit Supply Corp., ...
F. (2d) ..., 48 USPQ 667, 669;

Donner v. Sheer Pharmacal Corp., 64 F. (2d) 217
(C. C. A. 8);
Topliff v. Topliff, 145 U. S. 156, 161, 36 L. ed. 658.

16.

Simple inventions are frequently the most significant ones. The fact that these are simple devices is one basic reason for their success.

Krementz v. S. C. Cottle Co., 148 U. S. 556, 37 L. ed. 558;
Silver-Brown Co. v. Sheridan, 71 F. (2d) 935 (C. C. A. 1);
O. K. Jelks & Son v. Tom Houston Peanut Co., 52 F. (2d) 4 (C. C. A. 5);
Jensen-Salisbury Laboratories v. Salt Lake Stamp Co., 28 F. (2d) 99 (C. C. A. 8);
Van Heusen Prods., Inc., v. Earl & Wilson, 300 F. 922;
Barry v. Harpoon Castor Mfg. Co., 209 F. 207 (C. C. A. 2);
Magnus & Easterman Co. v. United-Carr Fastener Corp., 61 F. (2d) 13 (C. C. A. 6);
F. E. Fonseca Co. v. Ruy Suarez & Co., 232 F. 155 (C. C. A. 2);
Tulip Cup Corp. v. Ideal Cup Corp., 27 F. (2d) 717 (C. C. A. 2);
Julius Levine Co. v. Automatic Paper Mach. Co., 63 F. (2d) 547 (C. C. A. 3);
A. L. Randall Co. v. Hanson, 41 F. (2d) 596 (C. C. A. 7).

17.

Any force in the decision of the court below is destroyed by the grouping not only of claims, but of all the patents together as met by a group of references, without consideration of individual patents, or individual claims and inevitably without consideration of the individual patents relied upon by that court. The court below stated at the

trial that it did not distinguish between lamp shades and horse collars.

Wire Tie Machine Co. v. Pacific Box Co., 102 F. (2d) 543 (C. C. A. 9);

Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U. S. 477, 487, 79 L. ed. 1005.

18.

The decision in the District Court in Cleveland finding these patents valid and infringed gives great weight to them.

Claude Neon Electrical Products v. Brilliant Tube Sign Co., 48 F. (2d) 176 (C. C. A. 9);

National Electric Signalling Co. v. Telephone W. T. Co., 221 F. 629 (C. C. A. 2);

Dean Rubber Mfg. Co. v. Killian, 106 F. (2d) 316, 318 (C. C. A. 8).

ARGUMENT.

The Wasser Inventions Filled a Long-Felt Need.

The record shows that the inventions successfully filled a long-felt need in the art. Prior to the advent of the present inventions on the bottle collars, the only medium for this type of advertising was the flat hanger. No other type had ever been recognized commercially. Yet, it has been shown that this flat hanger was wholly inadequate. It was inefficient; its results were speculative.

The want for an adequate answer to this problem existed as long as the standard milk bottle has been used (R. 117, 120). The efforts of the art to arrive at an answer are additionally expressed in the prior patents cited by the defendant. It was only when plaintiff produced the inventions of the patents in suit that there ever was a business of this kind.

And *defendant* at the outset of this case *conceded* the *utility* of the bottle collars, "because it is recognized," to employ the words of defendant's counsel (R. 102).

This Court has expressed the law applicable to this situation in *Pyle Nat. Co. v. Lewin*, 92 F. (2d) 628, 630, as follows:

"It is also insisted that the idea involved in appellee's device is so simple and obvious it does not constitute invention. True, it now has that appearance. The fact, however, that this improvement was long overlooked, using devices far less satisfactory, cannot be ignored."

See, also:

Expanded Metal Co. v. Bradford, 214 U. S. 366, 381,
53 L. ed. 1034;

Forestek Plating & Mfg. Co. v. Knapp-Monarch Co.,
106 F. (2d) 554 (C. C. A. 6);

Crowder v. Armour, 105 F. (2d) 232, 236 (C. C.
A. 7).

Commercial Success.

It has been noted that Neher, an experienced dairy advertising man, immediately seized upon the bottle collars as the answer to the problem. His company became a licensee under the patent and, acting under that license, has sold an enormous number of the collars throughout the United States.

The interesting story of the building of a new business around the sale of bottle collars as a novel medium of advertising in the dairy industry is told by Neher beginning at page 121 of the record. Neher's previous experience in the field of dairy advertising told him that the bottle collar was the answer that he had long sought (R. 117, 120). The manner of its exploitation shows that the dairy industry itself saw in the bottle collar something unique and peculiarly desirable.

Neher did not start a large and expensive exploitation program. First, he merely called on a number of dairies in Chicago, Minneapolis, Detroit, New York, Washington and other large cities. He simply showed these dairies what the bottle collar was, in rough layout form. In the latter part of 1928 Neher returned to St. Louis and started into production. The major part of the dairies called upon gave him orders, which were filled beginning in May, 1929. For all of the delay, his company sold 14,000,000 collars in 1929.

Thereafter, Neher's company solicited business by direct mail without any of the fanfare that usually accompanies the introduction of new products.

Large chain dairies took on the bottle collars. In May of 1929, for instance, they had orders from Los Angeles and Seattle as well as eastern localities. Later, the small dairies took up the bottle collars. Dairies used bottle collars in programs of twelve to twenty-four issues of bottle collars a year (R. 108). To show the significance of this,

a comparison of the previous experience of the Golden State Company of San Francisco with flat hangers showed a use of only half a dozen issues of that type of advertising in a year (R. 108).

Among the large chain dairies that have used the bottle collars are National Dairy with headquarters in New York and dairies over the country. There is also the Borden Company, in business not only in the United States, but also in Canada, with a San Francisco and a Los Angeles outlet. (There is no connection between that Borden Company and the defendant.) The Beatrice Company has used bottle collars for a program for their entire territory for five straight years (R. 126).

The West Coast activities of the plaintiff started in 1929 at Los Angeles. Neher's company sold to the Golden State Company in San Francisco as early as 1930 and to the Marin-Dell Company in 1931. The use by Golden State is corroborated by Stewart, its former advertising manager (R. 130). One hundred and sixty-three dairies in California have used bottle collars from the plaintiff's licensee.

Furthermore, certain outside organizations have employed bottle collars to advertise on the milk bottles. The Red Cross for seven years has standardized on bottle collars as a means of advertising. The State of New York has used bottle collars to disseminate information from its Milk Control Department. In short, bottle collars have been sold in every state of the Union, in Canada and in Honolulu. Every one of these sales has occurred since the inventions by Wasser. *Prior to Wasser's inventions there was no bottle collar business.*

The figures for the bottle collars sold from 1929 through the first seven months of 1939 aggregated some 438,000,000 with a total value of over \$1,000,000.00. For a simple, inexpensive piece of advertising, these are highly significant figures.

The law on such commercial success is clear. When an article fills a long-felt need so successfully that the public pays it the tribute of enormous purchases, that clearly evidences the fact that the creation of the article involved invention.

- Research Products Co. v. Tretolite Co.*, 106 F. (2d) 530 (C. C. A. 9);
Forestek Plating & Mfg. Co. v. Knapp-Monarch Co., 106 F. (2d) 554 (C. C. A. 6);
Cincinnati Rubber Mfg. Co. v. Stowe-Woodward, Inc., 111 F. (2d) 239 (C. C. A. 6);
Bankers' Utilities Co. v. Pacific National Bank, 18 F. (2d) 16 (C. C. A. 9);
Minerals Separation v. Hyde, 242 U. S. 261, 61 L. ed. 286;
Eibel Process Co. v. Minnesota & O. Paper Co., 261 U. S. 45, 67 L. ed. 520;
Ace Patents Corp. v. The Exhibit Supply Co., ... F. (2d) ... (C. C. A. 7).

The Ninth Circuit Court of Appeals in the *Research Products* case said:

“So great and immediate a success speaks strongly of invention, adding emphasis to the strong presumption of invention, raised by the issuance of the patent.”

The Confessed Utility of the Devices Bespeaks Their Being Inventions.

The *Cincinnati Rubber Co.* case is of particular interest here in view of defendant's confession of utility. At 111 F. (2d) 241 the Court said:

“It had commercial success and its utility is admitted. We think it constituted an advance of decided merit.”

This same law is expressed by this Court in *National Nut Co. v. Sontag Chain Stores Co.*, 107 F. (2d) 318 (rev. oth. gds.), 334:

“We recognize, of course, that utility itself does not conclusively prove invention, but it should be accorded great weight in determining the question of invention.”

Public Acquiescence in the Patents.

During the course of the years, there have been a number of persons who have infringed the patents. As a result several suits have been filed, including that of Pevely Dairy Company v. Rusling Wood in New York; Pevely Dairy Company v. Manhard in San Francisco, and Pevely Dairy Company v. Tucker in New York, all three of which resulted in consent decrees, the defendants there recognizing the patents of plaintiff and, in each case, suffering injunction against future infringement. A fourth case, that of Pevely Dairy Company v. Golden State Company in San Francisco in 1934 was determined by dismissal without prejudice under agreement of that company to cease infringement and to buy its collars from plaintiff's licensee, Neher-Whitehead & Company (R. 152).

The record contains certified copies of the proceedings in these several cases, save for that of the Manhard case, of which this Court can take judicial notice (R. 100).

The Golden State, Manhard and Rusling Wood cases were on patent No. 1,829,915. The Tucker case was on patent No. 1,999,011. Thus bottle collars have been made commercially under both patents.

In addition to the foregoing suits, there was a case entitled Pevely Dairy Company v. Wolf Envelope Company in the District Court at Cleveland, Ohio, which involved infringements of both patents, and which resulted in a decree of validity and infringement of both patents after a hot contest. No appeal on this case was perfected. The decision was not reported, but the pleadings and findings of fact appear in the present record as Exhibits 11-11E. A more detailed consideration of this suit will be given

hereafter. This suit further corroborated the actual manufacture of collars under both patents.

The foregoing shows public acquiescence in both patents on appeal. In *Keasbey & Mattison Co. v. Philip Carey Mfg. Co.*, 139 F. 571, the court said (p. 573):

“* * * For 14 years the recognition of the patent by the public and acquiescence in its claims was unbroken and complete. If this were due solely to the conviction that the patent could not be successfully infringed it furnishes persuasive proof of its validity * * *.”

Infringement.

The matter of infringement requires, first, a decision as to the actual mechanical construction of certain of defendant's bottle collars, namely, to Exhibits 3, 4 and 5. This first issue does not apply to Exhibits 21 and 22.

The Construction of Exhibits 3 and 4.

Exhibit 3, a tracing of which may be seen in Exhibit 28, has a tab on one end that engages a slit at the other end. When this attachment is made, the collar assumes the form of a frustum of a cone. The sizing and shaping of the upper and lower edges of the strip of paper from which the collar is formed are such that the collar will have a lower diameter approximately equal to the diameter of the body portion of the bottle, and an upper diameter approximately equal to an intermediate diameter of the bottle neck. These facts are immediately apparent from the collar itself when it is placed on a bottle. It may be observed that both patents here involved disclose irregular upper edges, evidencing the fact that the upper diameter is not required to be parallel to the lower. The first question as to these Exhibits 3, 4 and 5 is as to whether the connection of the ends is pivotal or immovable.

Referring to Exhibit 3, there is not the slightest doubt

that there can be a pivotal action which takes place about the bottom of the notch on the tab end of the arcuate strip. This pivotal action alters the size of the upper diameter and provides the freedom necessary to permit the collar to settle snugly on the taper of the bottle neck.

Furthermore, claim 4 does not require specifically a pivotal connection. The term has been used in this case more as a matter of convenience. The limitation expressed in the claim is that it shall be one "permitting enlargement of the upper diameter of the member." The connection of Exhibit 3 permits this enlargement in two ways. One is the pivotal action described, and the other lies in the fact that the junction of the two ends occurs so far down from the top edge of the collar that the top edges themselves can deform outwardly to permit the collar to pass over any kind of a bottle flange.

It has been previously noted that the size of bottle flanges varies. Furthermore, dairies frequently use overhanging protective or so-called sanitary caps. Either of these two actions described can enable this collar to slip over any bottle flange within the range of expected widths and whether or not it has on it a cap.

It is worthy of note that the Cleveland court held that a collar there accused infringed this claim 4 because, although it did not have any pivoting in its connection, it did have the joint disposed so far below the upper edge that the upper edge could enlarge by the deformation described.¹

In plaintiff's opinion, Exhibit 3 is definitely a type of

¹ Exhibit 11 contains that court's Finding No. 5, which is as follows:

"5. That the defendant, The Wolf Envelope Company, has infringed letters patent No. 1,829,915 by making and selling and offering for sale a display device such as identified on the record as Plaintiff's Exhibit 3, said device being made from a strip of arcuate material shaped to conform to the dimensions of a tapered neck bottle; with an immovable connection joining the overlapped ends toward their lower edges but spaced downwardly from the upper edges so that the overlapping ends may part to permit the device to be passed over the bottle flange, even though the upper diameter is less than that of the flange."

collar coming under the limitations of claim 4. It has the desirable characteristics of claim 4. There must have been a reason to adopt the features, and the only explanation is that they were desirable for the same reason Wasser discovered their desirability eight years prior to defendant's entry into the field.

Exhibit 4 differs from Exhibit 3 only in that it has a lower tab as well as the upper one. It may be observed, however, that the shaping of the tab is such as to permit pivotal action. Although this pivoting is limited in degree, it is enough to influence the upper diameter and also to permit adjustment of the taper of the collar so that it may rest snugly about the neck of the bottle. The degree of pivoting is comparable to that employed by Neher in Exhibit 25.

Of course, the connection here is disposed so far below the upper edge of the collar as to permit the same enlargement that was found to be infringement in the Cleveland suit.

Defendant takes the position that Exhibits 3 and 4 do not have the pivotal connection (R. 196). In so doing, defendant was compelled to take the position that the ends of the collar were fixedly connected, and thereby it put this collar under claim 3 of the other patent 1,999,011, because this collar does have the lower diameter approximately equal to the body portion of the bottle, and it does have an upper diameter approximately equal to the top flange of the bottle, and it does have its wall so shaped that the upper edge rests at different distances from the axis of the bottle owing to the fact that the upper edge is at different elevations on the tapered neck.

Hence, the simplest way to decide the issue of Exhibits 3 and 4 is to determine first whether they are to be considered as having the connection called for by claim 4, or as having an immovable connection.

Plaintiff considers that these are connected so as to per-

mit enlargement of the upper diameter. Owing to the defendant's position, plaintiff proved at the trial that, even if defendant's contention were correct, the collars would come under patent 1,999,011. Defendant was fully aware of this position from the bill of particulars prior to trial (R. 23) and from the statements on the record at the trial.

Infringement of Patent No. 1,829,915 by

Exhibits 3, 4 and 5.

The chart, Exhibit 28, shows the claims divided into elements on one side, photostated from the patents, and on the other side shows accurate tracings of the collars in suit. Any collar may thus be compared with any claim.

Claim 4 requires:

1. A display device for application to a bottle having a cylindrical body portion, a tapered neck portion defining an enlarged mouth, and an enlarged top flange.

This is obviously true of Exhibit 3. The device is to be one comprising:

2. an arcuate piece of pliable material adapted to be formed into a truncated conical member.

This is also true of Exhibit 3. The patent refers to both the strip of Fig. 1 and the strip of Fig. 4 as arcuate. The word merely means that the device is made from a strip "bent or curved in the form of a bow," as Webster's Dictionary defines the term. The collar must also be one having:

3. a lower diameter approximately equal to the diameter of the body portion of the bottle.

This is true at a glance at Exhibit 3. Borden himself agreed that all the collars in suit "fit well down on the shoulder of the bottle towards its body."

4. an upper diameter approximately equal to an

intermediate diameter of the tapered neck portion of the bottle.

This is to enable getting a fit closely to the bottle neck “like a glove,” and this despite the enlarged flange. It is obviously present in Exhibit 3.

The claim requires only that these dimensions shall “approximately” equal those of the bottle. This word is entitled to latitude. *Chicago Pneumatic Tool Co. v. Hughes Tool Co.*, 97 F. (2d) 945 (C. C. A. 10).

5. means for so connecting the ends of said arcuate piece as to hold the same in the form of the truncated conical member—by means of which the devices may be held in conical shape and thereafter applied to the bottles—and permitting enlargement of the upper diameter of the member.

This, plaintiff contends, is clearly present in Exhibit 3.

Infringement by the other exhibits is equally apparent from the chart. Exhibit 4 is identical with Exhibit 3 except for the addition of one tab. As noted, plaintiff contends that there remains enough play to permit the device to fit more easily over a bottle flange, and to enable it to adjust itself to the shape of the bottle neck despite having a top opening large enough to fit over the bottle flange.

As a result of embodying the above elements, the accused exhibits obtain all of the desirable attributes expressed in the patent. They fulfill the statements in the patent as follows (R. 353, line 46):

“An object of the present invention is to provide a display device designed and constructed and adapted so that it may be passed over the relatively large circumferential flange at the upper end of the bottle neck and caused to engage against the tapered portion of the upper end of the bottle and thus support the display device for the most part above the cylindrical body of the bottle and around the tapered portion thereof and below said flange.”

and further (line 62) are arranged:

“so as to provide approximately conical display devices constructed in proportion, so that the display devices may be passed downwardly over the flange at the end of the bottle neck without tearing the paper,
* * * ,”

The accused exhibits also follow the statement (line 87):

“The construction which I have devised leaves the bottle neck flange and an adjacent portion of the bottle neck exposed, so that the individual milk bottle may easily be grasped by the hand without engaging the display device on said bottles.”

Also (R. 355, line 8):

“When the device is on the bottle, the lower end of said device is approximately at the beginning of the taper of the bottle and the lower edge of the device is approximately of the same diameter as the diameter of the body 8. Accordingly, the device fits snugly upon the lower end of the tapered portion 7 of the bottle and is supported thereby in such a position as to display the advertisements carried by the device.”

And (line 88):

“The smaller end of the conical device is of sufficient size to permit the end and neck of the bottle to pass therethrough but will not permit passage of the larger portion of the bottle beyond the neck thereof. Thus, the device will be supported upon and about the neck of the bottle and constitutes an inexpensive and highly desirable device that may be manufactured at permissible cost and applied without difficulty.”

It is apparent from the foregoing that defendant has deliberately invaded the rightful domain of plaintiff's patent 1,829,915 by its manufacture and sale of the bottle collars of exhibits 3, 4 and 5, by combining all of the elements of the claims for the manifest purpose of gaining all of the advantages flowing from these combinations.

The law in support of plaintiff's position is that well established by the decisions of this and other Courts.

Wire Tie Mach. Co. v. Pacific Box Co., 102 F. (2d) 543 (C. C. A. 9);

Nordberg Mfg. Co. v. Woolery Mach. Co., 79 F. (2d) 685 (C. C. A. 7);

Chicago Pneumatic Tool Co. v. Hughes, 97 F. (2d) 945 (C. C. A. 10);

Reinharts v. Caterpillar T. Corp., 85 F. (2d) 628 (C. C. A. 9);

Weiss v. R. Hoe & Co., 109 F. (2d) 722 (C. C. A. 2).

In the *Weiss* case the court said (p. 726):

“They have taken the substance of the invention and accomplished the same results by substantially the same means.”

Certainly the defendant's bottle collars differ from the patents in minor details such as the particular immovable connection in exhibits 21 and 22. All infringements do that—rare is the case of a Chinese copy. But the law allows no such escape. In the *Nordberg* case, at 79 F. (2d) 685, the court said (p. 692):

“* * * One appropriating the principle and mode of operation of a patent, and obtaining its results by the same or equivalent means, may not avoid infringement by making a device different in form, even though it be more or less efficient than the patented device.”

Infringement of Patent No. 1,999,011.

Exhibits 21 and 22.

Exhibits 21 and 22 contain connections that are immovable. The connections are rigid so as to prevent play and consequently less durability in the connecting parts.

It is desirable to have a bottle collar that extends well up on the bottle neck. Plaintiff's patents show this, and defendant's copies pay tribute to its value. Owing to the fact that a cone following the taper of the bottle neck soon

reaches a height where its top portion is smaller in diameter than the flange, a problem occurs in getting a high collar that will nevertheless pass over the flange and adhere to the taper of the bottle neck.

Wasser solved this problem in a way that is ingenious, and which also has the virtue of simplicity. He cut the upper edge of the strip down on the back side so that the collar would extend up on the front to give desirable "spot" advertising, and so that it would not fortuitously come off the bottle, but also so that the perimeter of the upper edge would be great enough to permit the collar to pass over the enlarged flange. More technically, the upper diameter was enlarged without sacrificing the other virtues of the collar.

This ingenious construction enabled Wasser to use an immovable connection of the ends of the strip, since the pivoting or enlarging feature no longer was essential. The immovability was desirable in that it tended to reduce wear on the attaching parts. Here is a peculiarly clear example of new combination where the elements interact upon each other to effect a new result. See:

- H. J. Heinz Co. v. Cohn*, 207 F. 547 (C. C. A. 9);
Wire Tie Machine Co. v. Pacific Box Co., 102 F. 543
(C. C. A. 9);
Webster Loom Co. v. Higgins, 105 U. S. 580, 26 L.
ed. 1177.

The combination of elements in Exhibits 21 and 22 is that of an arcuate piece of pliable material adapted to be formed into a truncated cone by overlapping the edge, together with a lower diameter approximately equal to the body portion of the bottle and an upper diameter approximately equal to the top flange of the bottle, with the wall of the cone being so shaped that, when the lower edge of the device is concentric with the longitudinal axis of the bottle portions, the upper edge of said device will be located

different distances from said axis, and with means for immovably connecting the overlapping ends of the piece of material.

The foregoing follows the words of claim 3. There is no doubt of the infringement by these two exhibits.

The defendant's position debates infringement on two grounds. The first is that the lower edge of the collar is not strictly level. This may or may not be true. But it certainly is inconsequential, because the variation, if it exists at all, is so slight as to have no significance whatever. If a patent is to be limited to this absurd extent, no patent can ever be of any value. It will be noted that the claim does not require the lower edge to be level. It merely requires that it have a lower diameter *approximately* equal to the body portion of the bottle. This is so obviously true of the collar that it seems beyond debate.

The second point of contention by the defendant is that the connection of the ends is not immovable. This argument is very hard to follow. Its position is that anything that can be detached at all is not immovable. If this were true, any part of any object that was attached by a screw and a nut would not be immovable, because it could be detached. Furthermore, such a contention is in conflict with the patent itself, which shows, in Fig. 9, a connection closely analogous to the type of connection used in Exhibits 21 and 22.

This peculiar position of the defendant is shown by the statement of Borden himself (R. 207). He said:

“When they are locked together it is for the purpose of keeping the upper part, here, from moving at all, from pivoting, but it is not immovably fastened together.”

Borden stated that the connection of Exhibits 21 and 22 could not be forced without mutilating the collar (R. 235). He also stated that (R. 236):

“There is no movement in the lock, no, but it is not immovable.”

Roemer was in just as bad a predicament on this same point. He testified that the connection of Exhibit 21 keeps the end of the arcuate strip relatively fixed (R. 298).

By what gyrations of mechanism—or words—two objects can be held against movement, but not be immovably connected, defendant’s witnesses do not make clear.

It is not the plaintiff’s contention that the particular type of immovable connection shown in Exhibits 21 and 22 is the type disclosed in the Wasser patent. Of course, it is not. The Wasser patent is not directed to a peculiar form of immovable connection. It shows half a dozen immovable connections, all of which are familiar practices in the art. One is gluing. Certainly, no one could get a patent on gluing two pieces together now. The patent says (R. 387, Col. 2, line 3):

“The construction and arrangement of the fastening means for holding the ends of the strip in relatively fixed relationship may be varied otherwise than as specifically described and within the scope of equivalent limits without departure from the nature and principle of the invention.”

The invention expressed in claim 3 of this patent is not the immovable connection, as such, but it is any immovable connection in this combination with the specified shapes of the arcuate strip including the shape of the upper edge such as to render the immovable connection possible. This is the combination adopted element for element by defendant.

Defendant has unmistakably adopted the irregular upper edge shape and the immovable connection for the exact objects set forth in patent 1,999,011. As stated in the patent (R. 386, Col. 2, line 18):

“My present invention comprises means for attach-

ing the ends of the blanks in relatively fixed relationship without slitting and thereby weakening the strip. The conical display devices in their finished form are of such size that when applied to the bottles for which they are intended the lower edge 2 is approximately at the upper end of the cylindrical body 7 of the bottle and at the beginning of the neck 6 while the upper edge 3 encircles an intermediate portion of the neck 6 and has a diameter at least as great as the diameter of the flange 5. Thus, the display device fits snugly on the neck of the bottle.”

Exhibits 3, 4 and 5.

As to infringement of Exhibits 3, 4 and 5 of this Wasser patent, the matter, of course, need not be considered if the Court agrees with the plaintiff that the connection actually is one that permits enlargement of the upper diameter. Only if the Court agrees with the defendant's position on the other patent 1,829,915 that the connection is not pivotal is it necessary to consider the argument immediately to follow.

Defendant was not able to avoid one or the other horn of its dilemma. Borden testified that, as to Exhibit 4 (R. 230):

“When that collar is put together properly there is no movement there at all, there is no enlargement of the top.”

He also testified (R. 232):

“It can't change its shape without being mutilated.”

He later reiterated that the connection is immovable (R. 234). These statements are not true, as anyone can observe by considering the collar itself. Despite this constant reiteration, the complete jumble of Borden's testimony is adequately shown by mere consideration of page 234 of the record. Either Borden simply did not know what was happening, or he had hold of a position which

was clearly untenable and dangerous, so that a proper explanation of it could not be given.

Roemer's position was equally anomalous. As to Exhibits 3, 4 and 5, he said that the connection was just as good as if the ends *were glued* together (R. 302). Apparently, he realized the problems of this position because he quibbled almost immediately, testifying (R. 303):

“Q. As a practical matter, this Exhibit 3, in your opinion, the connection is immovable; that is, immovable when it is in use? A. It is immovable in one sense of the word, yes.

Q. Well, immovable in the only sense in which it is significant; isn't that true? A. No. It can be taken apart and placed together; it is not glued together.

Q. Would there be any utility in gluing it together, or stapling it together over what you conceive to be this construction where it will not move at the connection? A. I see none.”

Now, certainly, it is clear enough from this testimony that, according to defendant's theory, the connections are not pivotal and are fixed just the same as if they were glued or stapled together. Therefore, under defendant's theory, they unmistakably fall under the immovable connection requirement of patent 1,999,011.

The remaining elements of claim 3 of this patent are present in all of Exhibits 3, 4, 21 and 22, as was testified to by defendant's own witness Borden. He agreed that (R. 236):

“Q. Now, I will ask you again, referring to the axis of this bottle, whether this upper diameter, or, rather, the upper perimeter is at varying distances from that axis.

A. The top of the upper section would be closer to the axis than the lower section, because the lower section, fitting on a wider portion of the flange of the neck, naturally makes it protrude further out from the axis of the bottle.”

Thus, Borden agreed that the upper edge has the shape required by claim 3 of patent 1,999,011. He also agreed that all of the collars come down to the shoulder of the bottle (id.). He agreed that the top had been cut on a slope so that it would pass over the flange of the bottle (R. 238), and he testified that the upper opening was sufficient to go over the flange of the bottle (R. 238). Borden's testimony establishes response to the elements of claim 3.

Therefore, if the Court has accepted the defendant's contention as to the immovability of the connections of Exhibits 3 and 4, there is no conclusion that can be derived except that these collars infringe patent 1,999,011.

It is unusual to have a case wherein this sort of situation can exist. Usually, in patent suits, if noninfringement is found of a particular patent, the plaintiff can sue on an additional patent which supplements the first one, as patent 1,999,011 supplements 1,829,915. Fortunately here, these two suits can be consolidated into one because the plaintiff already has the latter patent involved in this because of the clear infringement of it by Exhibits 21 and 22. Therefore, a second infringement suit is avoided.

Plaintiff's position remains that Exhibits 3 and 4 infringe patent 1,829,915 and that Exhibits 21 and 22 infringe patent 1,999,011. However, if defendant should prevail as to Exhibits 3 and 4 on the question of noninfringement of patent 1,829,915, the defendant is then in a hopeless position because, by its very proof, it establishes infringement of 1,999,011. As Judge Taft said, there is no case stronger than one made on cross-examination of an opponent's witness.

Defendant has adopted the sloping top and the immovable connection for precisely the objects of the Wasser patent. This establishes infringement.

Wire Tie Mach. Co. v. Pacific Box Co., 102 F. (2d)
543 (C. C. A. 9);

Nordberg Mfg. Co. v. Woolery Mach. Co., 79 F. (2d)
685 (C. C. A. 7);
Chicago Pneumatic Tool Co. v. Hughes, 97 F. (2d)
945 (C. C. A. 10).

The Defenses.

The policy of defense employed by the defendant is what we in Missouri would call a shotgun defense. A load of shot are sent out in the hope that one will land, or at least that so much confusion can be caused by their number that fallacy and the futility of individual issues are clouded from view.

A study of defendant's record and previous brief does not disclose that many of these issues were ever brought clearly into the open by the defendant. There has been rather a tendency to leave syllogisms unfinished and rest the arguments on momentum rather than conclusions.

Frankly, it is doubted that the defendant will resort to all of these defenses on the appeal. However, the plaintiff is fully willing to meet them all provided they will be brought clearly into the open and stated in tangible form so as to be answered with tangible responses.

The Matter of Joinder of Plaintiff's Licensee.

This whole matter is completely answered by one Supreme Court case, namely, *Waterman v. Mackenzie*, 138 U. S. 252, 34 L. ed. 923.

Plaintiff granted a license to Neher-Whitehead & Company to make and to sell, but not to use, the inventions of the patents in suit. This license appears in the record as Exhibit L.

Whatever may be said for the exclusiveness of the rights to make and to sell, the absence of the right to use prevents the relationship from being one requiring the joinder of the licensee as a co-plaintiff.

In *Waterman v. Mackenzie*, the court said (p. 926):

“* * * a grant of an exclusive right * * * which

does not include the right to make, and the right to use, and the right to sell, * * * is * * * only a license. * * * So is an instrument granting 'the sole right and privilege of manufacturing and selling' patented articles, and not expressly authorizing their use, because, though this might carry by implication the right to use articles made under the patent by the licensee, it certainly would not authorize him to use such articles made by others. *Hayward v. Andrews*, 106 U. S. 672 (27:271). See, also, *Oliver v. Rumford Chemical Works*, 109 U. S. 75 (27:862)."

See, also, *Hayward v. Andrews*, 106 U. S. 672, 27 L. ed. 271; *Independent Wireless Telegraph Company v. Radio Corporation of America*, 269 U. S. 459, 70 L. ed. 356; *Birdsall v. Shaliol*, 12 U. S. 485, 28 L. ed. 768.

An interesting point about this defense is that the defendant was fully aware of the existence of the license several months prior to bringing the suit and well over a year prior to the trial. It had full opportunity to develop this point by interrogatories or depositions, and to make any desired motion prior to the trial, but did not do so. Aside from the fact that the failure to bring it in earlier probably legally forecloses the right to do so now, and also despite the fact that, even if necessary, the additional party could be added at any time under Federal Rule 21, the unexplained delay in raising the point throws all of the equities to plaintiff's favor. The Supreme Court, in *Bourdieu v. Pacific Western Oil Company*, 299 U. S. 65, 70, 81 L. ed. 42, said:

"The rule is that if the merits of the cause may be determined without prejudice to the rights of necessary (indispensable) parties, absent and beyond the jurisdiction of the court, it will be done; and a court of equity will strain hard to reach that result."

The defense is untenable in the law and is certainly inequitably late. This is one of the defenses that we frankly doubt will be injected into the appeal.

The Alleged Double Patenting.

The claims of the patents here involved are wholly distinct. Double patenting exists only where there are generic claims in both patents that dominate the species claims of both patents. The mere fact that both patents may show exactly the same constructions is not controlling at all and, in fact, frequently happens. Indeed, it always happens where one patent is a division of another. The law is, as stated in *Montgomery Ward & Co. v. Gibbs*, 27 F. (2d) 466, 469 (C. C. A. 4):

“* * * It is immaterial, that the earlier and later of two copending patents make identically the same disclosure, if the same elements are not found in the combination set forth in the two claims under comparison. * * *

“There is no law requiring that all features must be claimed in the first patent issued. * * *

“It is not fatal if the invention of the second patent is disclosed in the earlier patent, provided it is not claimed there, and the applications for the two patents were copending * * *.”

See, also, additional cases, p. . . . , *supra*, point 7.

The broadest claim in patent 1,999,011 here in suit is claim 3. It cannot cover the combinations of the claims of patent 1,829,915 because claim 3 specifies that the connection be immovable, whereas the claims of 1,829,915 require a pivotal or expansible connection. Hence, this defense of double patenting is fully met by the law expressed in the *Montgomery Ward* case.

This is another defense that we frankly doubt will be raised on the appeal because it is so obviously untenable. If, however, the defendant does inject it, plaintiff calls upon defendant to state specifically wherein there are overlapping claims. Only then can there be even a proper raising of the defense.

The Alleged Unfair Competition of a Third Party.

Defendant filed a counterclaim for unfair competition. Plaintiff elicited from defendant the information that this so-called unfair competition related to activities of Neher-Whitehead & Company, plaintiff's licensee, which is not a party to this suit, and over which plaintiff could exercise no control. Certainly a licensor is not responsible for the torts of its licensee. However, in order to investigate fully this matter of alleged unfair competition, plaintiff required that defendant specify by bill of particulars all instances and persons with whom this so-called unfair competition had been involved. Thereupon, defendant listed certain companies in San Francisco as having been involved in this matter (R. 61).

Plaintiff felt that the whole matter of unfair competition was beyond the compass of this case, because it involved representations made by Neher-Whitehead & Company which, even if actionable, were not under the control of plaintiff and for which plaintiff certainly could not be responsible. However, it was, of course, necessary for plaintiff to investigate the situation. Plaintiff's counsel spent several additional days in San Francisco making this investigation and found to its satisfaction that the allegations were completely groundless. In fact, the reason for injecting this counterclaim was even less apparent after the investigation than prior to it.

At the trial, the only proof whatever of the counterclaim was the offering of one letter (Exh. U, R. 189-193), written by Neher-Whitehead & Company and not by plaintiff, which was *wholly outside the purportedly complete list of persons given by defendant* in its bill of particulars in response to plaintiff's request to specify every instance of allegedly unfair competition, and the statement of Borden that defendant's customers required it to agree to indemnify them if they purchased bottle collars from it. How

this could be unfair competition against anybody is certainly far from apparent. How it could be unfair competition against plaintiff, who was not a party to the letter in any way, shape or form, is beyond reason.

The whole matter had no place in this record at all, is wholly immaterial, and under no circumstances could be considered unfair competition against anybody. The counterclaim was improperly conceived and utterly unproved.

This sort of defense is subject to condemnation by this Court. It is not an open defense. It seeks only to infer by the principle of confusion that plaintiff has been guilty of something which was not even evil, and for which, in any event, plaintiff was not responsible (R. 141).

Defense of Invalidity.

Defendant's attitude towards infringement has already been expressed. The remaining defense offered by the defendant is that of invalidity. This defense is the only one that the lower court considered and it is the one forming the basis of this appeal.

Defendant's Resort to an Enormous Quantity of Art.

The defendant graced its answer with some seventy-seven prior patents and ten alleged prior users. No finer tribute to the patentability of these two bottle collar patents could be paid than the citation of such a colossal number of alleged prior patentees and prior users.

Yet, these eighty-seven items turned out to be incomplete. At the trial five additional patents were cited and several additional exhibits were entered so that the aggregate prior art for the patents comprised just under one hundred items.

When the trial was held the number of prior patents relied upon amounted in number to twenty-seven for the three patents. Finally, defendant, in its findings of fact, set up ten references against each of the two patents in suit, aggregating twenty in all.

This very fact brings into sharp relief the actual patentability of these inventions. In *A. S. Boyle v. Harris-Thomas Co. et al.*, 18 F. Supp. 177, the court said (p. 179):

“The defendant has put in evidence eighty-five patents and several excerpts from textbooks and publications. * * *

“ * * * Piecing together excerpts and elements from this wide search, they have built up a formidable speculative argument to show how simple and easy was the step taken by Andrews. This is a form of argumentation familiar in patent litigation. Though it seldom succeeds, it is often the only recourse of the infringer. The patent law, however, has its proper place in the realm of actual industrial life, and not in the limboes of parchment casuistry. * * *

“It is unnecessary to single out any one of these eighty-five patents for particular comment. It is enough to say that they show that inventors, at least since 1855, have been experimenting with the properties of nitrocellulose.”

Other courts have held the same rule.

Forsyth v. Garlock et al., 142 F. 461;

Ball & Roller Bearing Co. v. F. C. Sanford Mfg. Co.,
297 F. 163 (C. C. A. 2).

In the *Ball* case, *supra*, the court said (p. 167):

“The voluminous record at bar is the best (or worst) example recently presented to us of useless and misleading references to earlier patents and publications. It seems necessary to apply to patent litigation from time to time the maxim that one cannot make omelettes of bad eggs—no matter how many are used. One good reference is better than 50 poor ones, and the 50 do not make the one any better * * *.”

Not one of these eighty patents is shown to have ever been used, even for its specified and nonanalogous purpose. The only prior art ever used was the flat hanger, as agreed by both parties (R. 103, 114, 213).

The Art Cited Is From Wholly Remote and Nonanalogous Fields.

Defendant moved far and wide in its effort to find prior art against these patents.

As to patent 1,829,915, except for the file wrapper art cited by the Patent Office, the art relied upon by the defendant includes an 1870 patent for a tree protector, Knapp; a fifty-year-old patent on a paper box, Taylor; a twenty-five-year-old patent for a sleeve protector, Colby; a twenty-year-old patent on a jewelry holder, Schack, and a ten-year-old patent for a ham holder, Goes. In addition, defendant reinvoked and strongly relied upon the same prior art patents appearing in the file history of this patent.

The prior art not cited by the Patent Office but relied upon by defendant for patent 1,999,011 includes an 1886 patent on a flat label, Seeley; a patent on a fruit basket, Hoard, a British patent of 1901 on a metal clip for bottles, a thirty-five-year-old patent for a flower pot holder, and a twenty-three-year-old patent on a megaphone. Also defendant reurged the art from the file history of this patent.

Plaintiff's patents do not attempt to claim megaphones, or fruit baskets, or ham holders, particularly ancient ones that have spent so many years crumbling into dust in the Patent Office archives.

No prior art patents in this record disclose what may be called milk bottle collars. No prior art patents have the constructional, mechanical, individual elements recited by the claims in suit.

There is not only a clear case of new uses wholly foreign to the arts of the cited patents, but also there are specific novel and constructional elements wholly undisclosed by the prior art.

In such case the well-recognized rule clearly applies. In

Potts v. Creuger, 155 U. S. 597, 607, 39 L. ed. 275, the Supreme Court said (p. 279) :

“Indeed, it often requires as acute a perception of the relations between cause and effect, and as much of the peculiar intuitive genius which is a characteristic of great inventors, to grasp the idea that a device used in one art may be made available in another, as would be necessary to create the device *de novo*. And this is not the less true if, after the thing has been done, it appears to the ordinary mind so simple as to excite wonder that it was not thought of before. The apparent simplicity of a new device often leads an inexperienced person to think that it would have occurred to anyone familiar with the subject; but the decisive answer is that with dozens and perhaps hundreds of others laboring in the same field, it had never occurred to anyone before. The practiced eye of an ordinary mechanic may be safely trusted to see what ought to be apparent to everyone. * * * ”

This Court recently held valid a patent on a stove pipe against a similar attack in *Payne Furnace & Supply Co., Inc., v. William-Wallace Co.*, 117 F. (2d) 823, saying (p. 826) :

“* * * None of these discloses apparatus suitable or useful as a flue pipe. In none are found in combination all the essential elements of the present patent. Prior patents ‘cannot be reconstructed in the light of the invention in suit and then used as a part of the prior art.’ *Mohr & Son v. Alliance Securities Company*, 9 Cir., 14 F. (2d) 799, 800.”

In *Weiss v. R. Hoe & Co.*, 109 F. (2d) 722, the Second Circuit recently said of nonanalogous prior art (p. 725) :

“* * * For years these earlier patents had existed without suggesting to anyone a practical method of using highly volatile, fast-drying inks in rotary intaglio presses. The thought of Weiss was new, ingenious, and greatly contributed to a solution of the problem of speeding up production. Walker on Patents, 6th Ed.,

at page 98, states that: 'It may be invention to use an old * * * machine * * * for a new and nonanalogous purpose.' The same view has been expressed by Judge Denison in *Lyman Mfg. Co. v. Bassick Mfg. Co.*, 6 Cir., 18 F. 2d 29, 35, certiorari denied, *O. K. Mfg. Co. v. Bassick Mfg. Co.*, 275 U. S. 549, 48 S. Ct. 86, 72 L. Ed. 420, and *Lakewood Engineering Co. v. Walker*, 6 Cir., 23 F. 2d 623, 624. In the latter case he held that the quality of invention was present in the 'conception that the old material could be employed for this new use, coupled with the (thereupon) rather obvious mechanical changes which were necessary to make practical the application of the thought * * *.'

In *Cincinnati Rubber Co. v. Stowe-Woodward*, 111 F. (2d) 239, the Sixth Circuit last year said (p. 241):

"To support its contention that the claims are anticipated, appellant cites patents for clothes wringers, fruit presses, and for reducing wood to pulp. These patents are in a remote, nonanalogous art and do not anticipate. *National Hollow B. B. Co. v. Interchangeable B. B. Co.*, 8 Cir., 106 F. 693, 702."

A singularly appropriate case is *Tyra v. Adler*, 85 F. (2d) 548, wherein the Sixth Circuit held (p. 552):

"* * * In this case the arts are wholly different and the functions distinct. Metal strips may be used in innumerable industries, but that fact does not prove want of novelty and invention in a combination where they are used in a new way with new adaptations and for a wholly different purpose, especially where as here the modifications effect a new and beneficial result. *Potts & Co. v. Creager*, 155 U. S. 597, 607, 15 S. Ct. 194, 39 L. Ed. 275; *Silver-Brown Co. v. Sheridan* (C. C. A. 1) 71 F. (2d) 935, 937."

See, also:

Electric Candy Machine Co. v. Morris, 156 F. 972, 976;

Peerless Equipment Co. v. W. H. Miner, Inc., 93 F. (2d) 98 (C. C. A. 7).

Validity of Patent No. 1,829,915.

It has previously been pointed out that patent No. 1,829,915 is for a particular kind of bottle collar for use on bottles such as milk bottles. It is not just any wrapping for the neck of a bottle, but it is a removable collar in the shape of a truncated cone that is formed from an arcuate strip of material. The lower edge of this arcuate strip has a curvature of defined shape so that when made into a cone the lower diameter of the cone shall approximately equal the diameter of the bottle at the shoulder. The arcuate strip has an upper curvature that may be irregular but is, nevertheless, such that when the strip is formed into a cone the upper diameter shall approximately equal an intermediate diameter of the tapered neck portion of the bottle. By these two limitations the collar extends approximately to the shoulder of the bottle, spreads well upwardly along the neck, and adheres closely to the taper of the neck so as to permit icing, and to prevent the collar's fortuitous removal, and to provide the other advantages to which reference has previously been made.

But the collar has additional limitations. It has means connecting the ends of such character as to hold the collar in the form of the truncated cone, but, at the same time, to permit enlargement of the upper diameter. This forms the new combination whereby the collar may conform thereafter to the shape of the tapered neck.

Previously it has been stated that the prior art relied upon in the effort to meet this combination comprises a tree protector, a paper box, a sleeve protector, a jewelry holder and a ham holder, which are offered as the so-called art "not cited by the Patent Office." To this was added the art cited and rejected by the Patent Office; a lamp shade, a British patent for a metal clip for medicine bottles, and a Swiss patent for a drop catcher for wine bottles.

This very listing of the prior art patents indicates that these wholly remote patents, added by defendant to the art cited and rejected by the Patent Office, cannot possibly overcome the presumption of validity attaching to the patent. The Patent Office search was far better than that of defendant, and to use defendant's remote patents in a technical effort to destroy the presumption would constitute a corruption of the rule.

Such an obvious distortion of the rule is not permitted. In *Nerney v. New York, N. H. & H. R. Co.*, 6 F. Supp. 554, 557, the court said:

“* * * It is significant that this McWhirter patent is practically the same as the Ackley patent cited by the Examiner against the Sauvage application. In the first place, this evidences the thorough character of the search by the Patent Office, and strengthens the presumption of validity due to the grant of the patent. Secondly, it is always significant when a defendant, after exhaustively searching for material with which to attack the validity of a patent, can point to nothing more pertinent than what the Examiner cited in the proceedings which led to the grant of the patent in suit, * * *.”

See, also, *Dean Rubber Mfg. Co. v. Killian*, 106 F. (2d) 316, 318 (C. C. A. 8).

The Findings of Fact “prepared by the attorneys for the defendant” (R. 73) depart from the above list of prior art employed by defendant at the trial, and rely upon the patents to Guardino, Taylor, Goes and Gridley to meet the claims of the patent, together with the Patent Office art. But defendant also refers to certain exhibits of these patents. These exhibits were put into the record over the active objection of the plaintiff and their admission forms the subject of appeal points 16-19 (R. 88). These so-called exhibits were made up immediately prior to the trial by defendant's witness Roemer. Upon Roemer's testimony

rests defendant's entire defense. At this point it is, therefore, necessary to consider the qualifications of this witness.

Qualifications of Defendant's Witness Roemer.

At the opening of the testimony of this witness Roemer, who was offered as an expert witness, is found the statement by him as follows (R. 244):

“* * * I am a patent attorney in the *employ* of the firm of Townsend & Hackley.”

Townsend & Hackley were the attorneys in the court below for defendant and one member of this former firm remains as attorney for the defendant on the appeal.

Roemer's total qualifications outlined on direct examination consisted of his having acted as a patent attorney and having solicited patents before the Patent Office. He also had read the patents in suit and their file histories. Beyond that, there was no effort to qualify this witness as an expert (R. 245).

On cross-examination it developed that this witness is not an engineer nor even an attorney at law. He had never been in the dairy business and had never been in the advertising business. This astonishing confession of lack of qualifications as an expert witness was culminated by the following testimony (R. 288):

“Q. What, if any, especial qualifications have you with respect to testifying on display devices connected particularly with the dairy business? A. Why, I am testifying to certain mechanical structures.

Q. Only that? A. Yes.”

A witness of this kind is hardly ever helpful in the case. Actually, he was merely a law clerk, not a member of the bar, in the office of the counsel for defendant. It is plaintiff's feeling that his testimony amounts to no more than a colloquy between counsel and his law clerk.

In the case of *The Gray Processes Corp. v. Danciger Oil & Refineries, Inc.*, 42 USPQ 315, a very similar situation arose in a patent suit in the District Court in Texas. Defendant based its evidence of invalidity of the patents there in suit upon the testimony of one Stokes. Of him the court said (p. 328):

“* * * He is not a lawyer nor a chemist, but has been admitted to practice as a solicitor in the Patent Office. He is not a graduate of any college or university, but has had several years of practical experience; * * *.”

Incidentally, the practical experience of this man Stokes had been in the art pertinent to that case, which is in sharp contrast to any practical experience claimed by Roemer.

Actually, Stokes, in the cited case, was a patent attorney, but not a member of the bar, in the office of counsel for defendant. Their offices had adjoined for a period of ten years, which is the same period claimed by Roemer for employment by Townsend & Hackley. There is this difference which would favor Stokes' testimony: Stokes was not financially connected with defendant's attorneys in the cited case. Roemer here was *employed* by counsel for defendant.

In *The Gray Processes* case the judge stated (p. 328):

“* * * The only difference I can see between Mr. Stokes (the expert) and the attorneys is the absence of a license, and that he does his work on the witness stand. Considering this fact and his entire background, including his lack of any substantial experience touching the scientific questions dealt with, his testimony is not calculated to inspire any more confidence than if one of the attorneys in the case had so prepared himself and taken the witness stand to testify as an expert. As a matter of fact, I have no doubt that Mr. Harris as to the patents and Mr. Foster on chemistry could have acquitted themselves as witnesses with a much higher order of skill and learning. * * * De-

defendant stakes its most important defense almost solely on his testimony. When he goes out of the case, the defense of anticipation and prior art to show lack of invention goes out also. * * * The insurmountable obstacle that Mr. Stokes labored under was a lack of practical knowledge and experience in the sciences revealed and dealt with in most of the publications and patents he was called upon to interpret. However skilled and practiced he was in patents, with that deficiency, his burden was too much."

Here, as in the cited case, the defendant stakes its most important defenses almost solely on the testimony of this unqualified expert witness. Such testimony is not convincing and is not entitled to much weight. This is particularly true in view of the testimony given, which was, as might be expected, wrongly founded in law, improper mechanically, and not of a type to inspire confidence. See, also, *Farmers Cooperative Exchange v. Turnbow*, 111 F. (2d) 728 (C. C. A. 9).

The So-Called Models.

Since defendant in its findings of fact injected the models, Exhibits GG, II, JJ, KK, and since the court employed these models, it is necessary to consider them. The model Exhibit GG was testified on direct examination to be a piece of paper cut to represent the blank illustrated in the Guardino patent. It was said to be "cut according to the teaching of the Guardino patent" (R. 273). On direct examination Roemer testified (R. 274) as follows:

"Q. Has that model that you just dropped over the bottle undergone any change other than size? A. No; it has been enlarged to fit a milk bottle. Of course, the one in the patent has been reduced to fit the paper."

He insisted, on direct examination, in response to questions of the court, that the model had been changed only by reduction in size (R. 274).

Now, it goes without saying that the ice cream box of the Guardino patent is a far cry from a bottle collar. It has in it a bottom which would, of course, prevent its going over a milk bottle. It has an entirely different proportion from these bottle collars as defined by the claims in suit.

In short, the insistence by this witness on direct examination, not only in response to the leading questions of the witness's fellow counsel or employer, but also in response to the questions of the court itself, are simply untrue testimony. The witness, of course, was unqualified as a patent expert and perhaps did not realize the impropriety of offering any such exhibits. But whatever the witness may have done because of a lack of qualification as a patent expert, there can be no excuse for such testimony as the witness gave, namely, that the only changes made in Exhibit GG over the Guardino patent lay in the actual size of the model.

On cross-examination the witness back-tracked and rendered wholly ineffective his testimony as to the model. He conceded that he had "transformed" the model (R. 290). He conceded that it was not an exact model of the Guardino patent despite the fact that he added confusion to his testimony by the statement on cross-examination (R. 291):

"I simply said, as I recall, it had been colored to make it more like a bottle collar."

Then, in a blanket denial that any of the models in question was a truthful representation of the disclosures upon which the direct examination professed them to be based, the witness said (R. 292):

"Well, if I did say that I would like to correct my testimony, because I did not mean to claim that any of these were exact reproductions."

If the Guardino model, Exhibit GG, is opened up, it will be seen not to conform even with the Guardino disclosure.

It would not even be the box represented in the Guardino patent, much less would it be a bottle collar.

The witness was not so ambitious in regard to the so-called model of the Taylor patent, Exhibit II. It was conceded that this model was not a representation of the Taylor patent except as to the slit and tongue. Why we need a model made up to illustrate the slit and tongue of the Taylor patent is certainly far from clear. It has been shown that the particular type of tongue and slot connection of any of the patents in suit is not critical. These patents are for *combinations* or new associations of connections with arcuate strips having new shapes to accomplish over-all new results. In any event, this model, made up long after the Taylor patent and even long after the patents on this appeal, was agreed by the witness to represent nothing more than the tongue and slit of the Taylor patent applied to a bottle collar (R. 277). In other words, one must know of bottle collars and their details before the Taylor tongue and slit can be applied to that art.

The model, Exhibit JJ, was likewise a distortion of the disclosure of the Goes patent. It will be remembered that the Goes patent is for a ham holder. It is a far cry from holding hams to bottle collars on milk bottles. But the witness agreed that he had even changed the disclosure of the Goes patent in order to make it into a bottle collar and he agreed that the only point for the introduction of this model was to show a particular tongue and slot connection, and this for reasons that are not apparent. The only claim made was that it showed this one feature (R. 277). Manifestly, it required modification of a substantial nature in order to make it into a bottle collar.

The model, Exhibit KK, relied upon by defendant in its findings of fact is another model made up for the purpose of this trial some seventy years after the Gridley patent issued. This model was not offered for anything except to show another type of tongue and slot connection, although

plaintiff's counsel apparently disagreed with his employee because he countered Roemer's limitation of the model as showing merely the tongue and slot connection. In fact, Roemer said (R. 279):

“Beyond that nothing * * *.”

These four models that crept into this litigation by the back door are, under no circumstances, prior art against the patents in suit. In fact, they demonstrate that bottle collars are more than fruit baskets, or charlotte russe boxes, or ham holders, if any such evidence were necessary.

This production of testimony, demonstrating peculiar types of tongue and slot connections, is offered presumably because of the misinterpretation of patent law upon which Roemer, perhaps because of his lack of qualification, based his whole theory of defense. This theory was necessarily adopted by defendant before the lower court and apparently with effect. If testimony as to particular types of tongues and slots in other uses was necessary to defendant's case, that case must fail because defendant did not bring any evidence of two pieces of material stapled together, or glued together, as required by patent 1,999,011. If this case is to go off on merely the manner of attaching the ends independently of the other features of the claim, then the defendant has failed to prove that two pieces can be glued together. Thus, Roemer testified (R. 254):

“Q. Now, briefly refer to the alleged novel features of this Wasser patent 1829. A. The Wasser patent 1829, like the one previously referred to, is directed to a bottle collar, and the novel features, like the first patent, pertain to means for fastening together the ends of the blank which hold the blank in a collar-like form.”

Obviously, plaintiff calls upon defendant to meet the combinations of the patents in suit. This it cannot do on this record.

The Art Relied Upon Is Inferior to That Elicited by the Patent Office.

On cross-examination, Roemer agreed that the nearest he could come to anticipating patent 1,829,915 was by the Goes, Colby, Taylor, and Spellman patents.

Goes, as we have stated, is the ham holder patent. Colby is a sleeve protector patent. Taylor is a paper box patent. Spellman is a lamp shade patent.

Now, there is no doubt that in this case the best art was cited by the Patent Office and these claims were allowed over that art. The Spellman patent, relied upon vigorously by the defendant and employed by the court to invalidate the patent, was in the file history of both patents on appeal. If the defendant is entitled to employ any arcuate piece of paper with the ends joined together to anticipate the specific arcuate piece of paper with specific sizes and dimensions and specific types of attachment, then the defendant must flatly disagree with the Patent Office and no better reference can be found than the Spellman patent. But the Patent Office allowed these claims over Spellman.

Furthermore, the Patent Office allowed the claims over the Huber Swiss patent. This patent is for a label for the neck of a bottle, which is more than can be said for any patent relied upon by defendant. It has a straight strip of material with a pivotal connection. We do not contend that the patents on appeal cover straight strips of material with pivotal connections and we have no objection whatever if defendant wants to make this illustration from the prior art. Defendant, however, tenaciously adheres to the constructions of the patents in suit because of their manifest advantages over this prior art.

Is it not equally significant in this case that defendant's search, which is, to say the least, exhaustive in view of its citing ninety-seven items from the prior art, can produce no more pertinent or even as pertinent prior art as that

cited by the Examiner during the pendency of the applications before the Patent Office?

Out of all of this maze of prior art, defendant has produced *nothing* which shows the *combination* of the Wasser patent. Its evidence of the prior art consists of a multitude of wholly remote structures that have nothing to do with the art in question. Unfortunately, the court below expressed at the trial a misstatement of the law that was manifestly reflected in its erroneous opinion. The court said (R. 170) during the introduction of these prior patents:

“The Court: What significance is there whether it is a horse collar or a lamp shade?”

Validity of Patent No. 1,999,011.

Patent 1,999,011, as has been shown, is for a *combination* of sizes and shapes of the elements of an arcuate strip such as to permit it to pass over the flange of the bottle and yet rest snugly against the tapered neck and, for all of this, to have an immovable connection of the ends of the strip. To all of the patents before it, as a group, the court below applied the five patents referred to on page 72 of the record in the court's memorandum, to wit, Guardino, Taylor, Goes, Gridley and Spellman, three boxes, a ham holder and a lamp shade. Incidentally, what any of these patents adds to the others no one knows.

Not one of these five patents referred to by the court below was employed by defendant at the trial in anticipation of patent 1,999,011.

Roemer relied mainly upon Seely, the British patent to Brown, the Hoard patent, Knowlton, Cheney and Tomlin against patent 1,999,011 (R. 286).

But the principal reference employed by Roemer was the Brown patent. This patent was one rejected by the Patent Office. It is thought that the briefest inspection of this

crude and foreign patent, appearing at page 398 of the record, will suffice to show how far afield this defense is.

It will be remembered that the combination expressed in claim 3 of patent 1,999,011 is a bottle collar for the tapered neck of a bottle. Brown is not such a bottle collar. Claim 3 requires that the lower diameter be approximately equal to the body portion of the bottle. The Brown device has no such lower diameter. Claim 3 requires that the upper diameter be approximately equal to the top flange of the bottle. This is necessary if the collar is to pass over the flange. Brown's collar in Fig. 3 does not do so. Brown specifies (R. 398, line 21) that:

“The disc is attached to the neck of the bottle by pulling the free ends of it apart in a direction at right angles to the plane of the disc, and it either springs back into the plane or it may be bent into this position and thus it becomes attached.”

This alone is enough to completely defeat the use of the Brown patent as a reference. The claim further requires that the upper edge of the cone rest at different distances from the axis of the bottle. Brown does not have this limitation, since the upper edge is in a plane. Claim 3 requires that there be means for removably connecting the overlapping ends of the material. Brown *does not even connect the ends at all* and, if he did, his device could not be put on the bottle. It is, after all, a metal piece that must be bent in order to be applied to the bottle.

The Brown patent issued in 1901. It never had any use as a bottle collar for milk bottles and could not. If defendant wants to use this type of a collar, plaintiff has no complaint to make. But let defendant use this prior art if it can and not infringe plaintiff's patents.

This Brown patent was the one Roemer claimed anticipated patent 1,999,011 (R. 309). Roemer's lack of qualifications both mechanically and legally are abundantly mani-

fested here. The witness could not have understood claim 3 or the British patent and still have assumed any such position. It is, however, upon this testimony that defendant rests its case.

More need hardly be said. Where does a ham holder, a sleeve protector, a lamp shade or a paper box constitute or remotely suggest a bottle collar? The lamp shade, just as good a representation of a frustrum of a cone as any of the other patents, was before the Patent Office but rejected by it as art against these claims. Certainly, conical frustrums are old. Euclid knew of them in ancient history. Why multiply them? This case is on *combinations* of peculiarly shaped and peculiarly constructed conical sections never before so shaped, so constructed, or so used. Let defendant bring in the new combinations if it insists on its right to destroy. Its road of destruction cannot be paved with conjecture and speculation and theory, for its burden is too heavy.

In *H. J. Heinz Co. v. Cohn*, 207 F. 547, this Court well stated the rule (p. 557):

“But in a combination of elements that are old, whereby through their new relation they perform new functions and produce a new result, there is patentable novelty. *Hailes v. Van Wormer*, 20 Wall. 353, 22 L. Ed. 241; *Taylor v. Sawyer Spindle Co.*, 75 Fed. 301, 22 C. C. A. 203.”

In *Wire Tie Machine Co. v. Pacific Box Corp.*, 102 F. (2d) 543, this Court said (p. 552):

“The Supreme Court in the case of *Webster Loom Co. v. Higgins*, 105 U. S. 580, 591, 26 L. Ed. 1177, gives its test as to what constitutes invention as follows: ‘It may be laid down as a general rule, though perhaps not an invariable one, that if a new combination and arrangement of known elements produce a new and beneficial result, never attained before, it is evidence of invention.’ ”

See, also:

Cold Metal Process Co. v. Carnegie-Illinois Steel Co., 108 F. (2d) 322 (C. C. A. 3);

National Hollow B. B. Co. v. Interchangeable B. B. Co., 106 F. 693 (C. C. A. 8);

Weiss v. R. Hoe & Co., 109 F. (2d) 722 (C. C. A. 2).

Combination Patents Are Met Only by Art Showing the Combination.

It is basic that combination claims are not met by prior art merely showing one or more, but not all of the elements of the combination. *No art here pretends to show the Wasser combinations.* In *Ace Patents Corp. v. The Exhibit Supply Co.*, ... F. (2d) ..., 48 USPQ 667, the Seventh Circuit Court said, just last March:

“True, appellants exhibited models alleged to embody the disclosures of Fisher, Dabos, and also Hooker. However, they are not full disclosures, or they are combinations of disclosures from more than one patent, and fail to read on the claim, either separately or in combination. If they did so read, they could not constitute anticipation of Nelson’s combination claim, for no single prior art device cited discloses all the elements of Nelson. *Chicago Lock Co. v. Tratsch*, 72 F. 2d 482.”

See, also, *Domer v. Sheer Pharmacal Corporation*, 64 F. (2d) 217, 220 (C. C. A. 8), in which case the Eighth Circuit reversed the district court, and thereby confirmed a previous opinion of another district court, just as we ask here. This basic rule is abundantly established by the cases. See *Topliff v. Topliff*, 145 U. S. 156, 161, 36 L. ed. 658; *H. W. Peters Co. v. MacDonald*, 59 F. (2d) 974 (C. C. A. 2).

Simple Inventions Are Often the Most Significant.

Simple inventions are frequently of outstanding merit. Many have been upheld, among which are:

Krementz v. S. Cottle Co., 148 U. S. 556, 37 L. ed.

- 558, wherein the Supreme Court found a one-piece collar button patent good;
- Silver-Brown Co. v. Sheridan*, 71 F. (2d) 935, 937 (C. C. A. 1), on a heel protector for stockings;
- O. K. Jelks & Son v. Tom Houston Peanut Co.*, 52 F. (2d) 4 (C. C. A. 5), on a peanut sack narrow enough to fit into one's hand and mouth;
- Jensen-Salisbury Laboratories v. Salt Lake Stamp Co.*, 28 F. (2d) 99 (C. C. A. 8), on an ear tag for identifying animals;
- Van Heusen Prods., Inc., v. Earl & Wilson*, 300 F. 922, on a multiple ply collar for shirts;
- Barry v. Harpoon Castor Mfg. Co.*, 209 F. 207 (C. C. A. 2), for "domes of silence" sliders for furniture;
- Magnus & Easterman Co. v. United-Carr Fastener Corp.*, 61 F. (2d) 13 (C. C. A. 6), on a snap fastener for securing auto rugs;
- F. E. Fonseca Co. v. Ruy Suarez & Co.*, 232 F. 155 (C. C. A. 2), on a cigar wrapper extending beyond the ends of the cigar to protect it;
- Tulip Cup Corp. v. Ideal Cup Corp.*, 27 F. (2d) 717 (C. C. A. 2), on a paper cup made of a single sheet with rolled rim;
- Julius Levine Co. v. Automatic Paper Mach. Co.*, 63 F. (2d) 547 (C. C. A. 3), on a box for holding paper roll, with metal cutting edge;
- A. L. Randall Co. v. Hanson*, 41 F. (2d) 596 (C. C. A. 7), on a flower pot holder formed from looped wire.

The Decision of the Court Below.

The decision of the court below is contained on page 72 of the record.

In this decision the court merely found that the alleged inventions for which

"Letters Patent No. 1,829,915, No. 1,999,011 and No. 1,923,856 were issued, were covered by the prior art set forth in Guardino Patent No. 1,300,164, Taylor Patent No. 343,866, Goes Patent No. 1,480,661, Gridley Patent

No. 63,629 and Spellman Patent No. 1,309,263 so as to make plaintiff's patents void for want of invention."

The findings of fact were drafted by defendant in accordance with the order. It is not intended to imply criticism of this procedure, but the tenor of the findings is naturally prejudiced.

However, the findings do not ultimately declare any more than that the several patents are invalid because of the five references cited by the court (R. 79). The same is repeated by conclusion No. 4.

The statement by the court does not take up the three Wasser patents separately. It does not tell which of the five patents were applied to which patent in suit. It does not take up the claims individually as required by the *Wire Tie* case in which this Court said, 102 F. (2d) 551:

"Claims of a patent are independent inventions. One may be infringed and other not; one may be valid and the rest invalid. The patent does not stand or fall as a unity. *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U. S. 301, 319, 29 S. Ct. 495, 53 L. Ed. 805 * * *."

This rule was recently fixed by the Supreme Court in *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U. S. 477, 487, 79 L. ed. 1005.

Of the five patents relied upon by the court, the Guardino and Gridley patents were applied by defendant at the trial only to the Wasser patent No. 1,923,856, which is not on appeal. The Taylor, the Goes and the Spellman patents were relied upon by defendant against Wasser Patent 1,829,915.

Not one of these five patents was relied upon by defendant at the trial against patent 1,999,011.

The Spellman patent appeared in the file history before the Patent Office of both of the two patents, and the claims in suit were allowed over that patent. It is also to be noted that defendant in preparing Finding No. 15 (R. 78) added

Guardino to the patents cited against Wasser 1,859,915, although this was not done at the trial. There is no basis on the record for this finding of fact.

It is not necessary to recapitulate the fact that the five references cited by the court are from wholly remote arts. There is not a bottle collar among them, nor anything like a bottle collar. The court below might as well have cited a funnel or megaphone or any one of the hundreds of conical shapes that exist in the world. Guardino is a charlotte russe box, Taylor is a paper box, Gridley is a box. Spellman is a lamp shade which is every bit as good as any of the other four and which was discarded by the Patent Office against the claim. Goes is a ham holder.

Defendant is fully entitled, as far as plaintiff is concerned, to make charlotte russe boxes, paper boxes, lamp shades, or ham holders. But defendant did not want to make those; it wanted to make bottle collars. Not only did it tenaciously insist upon making bottle collars, but it insisted upon making the particular bottle collars of plaintiff's patents.

It may be that the court was misled into employing these five references, because defendant made what purported to be models for each of these. Although an attack was made on the admissibility of these models, because they in point of uncontrovertible fact were not models of the several patents, they were admitted. Defendant finally agreed that these so-called models showed nothing more than particular types of interlocking means. Roemer did not attempt to make these models into actual anticipations of the elements of the claims in suit.

Perhaps the lower court arrived at its erroneous conclusion because of a complete misconception of the proper law. When defendant introduced the Spellman patent, without any comment from either party, the court remarked (R. 170):

“The Court: What significance is there whether it is a horse collar or a lamp shade?”

The significance may be realized in the factual sense by imagining a horse with a lamp shade around its neck, or a lamp shade with a horse collar around its top. In the legal sense, there is, of course, a tremendous difference, reinforced by the fact that each of the claims in suit differs structurally from the Spellman or any other lamp shade.

The decision of the court below cannot be sustained on this record and is wholly far-fetched and unreasonable.

The Pevely v. Wolf Suit.

The bill of complaint in Pevely v. Wolf tried before Judge Jones in Cleveland shows that the case involved both of the patents here on appeal. It shows further that, of the references relied upon by defendant in the court below, Taylor, Spellman, Heard, Brown, Cheney and Tomlin were before Judge Jones and rejected by him as anticipating or limiting either of the two patents (Exh. 12, Finding 27). It is perfectly apparent that this art before the court in Cleveland was just as good art as that before the court below. If anything, the art employed by defendant below is poorer than that before the Cleveland court and, as a matter of fact, before the Patent Office.

Judge Jones found the prior art that did not relate to display devices to be nonanalogous and not anticipating the patents in suit (Exh. 12, p. 9).

As a result of the Cleveland suit, the defendant there was enjoined by a final decree.

This hard fought litigation in the Cleveland suit is entitled to great weight. There is no prior art in the present case any closer than that employed in the Cleveland case, and the opinion by Judge Jones, who is a man of long years on the bench and in a district where many patent cases are tried, deserves consideration. It is felt that this

Cleveland decision follows the law in a way that the decision from which this appeal is taken does not.

That court recognized among other things the necessity of having prior art that is at least in the same line of endeavor as the patent sued upon. It recognized that devices, however simple in structure, may yet be inventive and that, indeed, the simplest things are frequently the most difficult to discover. It recognized that the defendant had paid particular tribute to the patents in suit by employing their inventions rather than alternatives. It recognized that the building of a business based upon astonishing commercial acceptance of the inventions, however simple, however small, however inexpensive, is a clear indication that the public sought and wanted the inventions; that it filled a long felt need and that it was invention.

Manifestly such a decision is entitled to great weight. This Court and others have so held:

Claude Neon Electric Prods. v. Brilliant Tube Sign Co., 48 F. (2d) 176 (C. C. A. 9);

National Electric Signalling Co. v. Telefunken W. T. Co., 221 F. 629 (C. C. A. 2);

Dean Rubber Mfg. Co. v. Killian, 106 F. (2d) 316, 318 (C. C. A. 8).

CONCLUSION.

In this brief, we have attempted to present plaintiff's side of the case, and we have attempted to analyze the defenses, because plaintiff believes in the principle of open justice openly arrived at. This confidence is fortified here by the conviction that the defenses are untenable.

Any failure to meet defenses is not of plaintiff's intention. There has been a tendency on the part of defendant to shift in its defenses to such an extent that plaintiff can never be sure that its arguments will be met head on.

Wasser made inventions in 1928 that have received singular tribute. The persistence of the defendant in

infringing them is a great tribute to their value. But this tribute is little compensation to plaintiff for the invasion of its rights and the destruction of the business built up over such a long period.

For this we ask a reversal of the decision below.

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